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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/427,892	10/26/1999	RAIMUND WEIFFEN	4452-263	3906

7590

04/09/2002

THOMAS C PONTANI ESQ  
COHEN PONTANI LIEBERMAN & PAVANE  
551 FIFTH AVENUE  
SUITE 1210  
NEW YORK, NY 10176

EXAMINER

WILLIAMS, THOMAS J

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 04/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant(s)

09/427,892

Applicant(s)

WEIFFEN ET AL.

Examiner

Thomas J. Williams

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**Peri d f r R ply**  
- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Acknowledgment is made in the receipt of amendment C filed January 18, 2002.
2. The papers filed on **February 11, 2002** (certificate of mailing dated **January 18, 2002**) have not been made part of the permanent records of the United States Patent and Trademark Office (Office) for this application (37 CFR 1.52(a)) because of damage from the United States Postal Service irradiation process. The above-identified papers, however, were not so damaged as to preclude the USPTO from making a legible copy of such papers. Therefore, the Office has made a copy of these papers, substituted them for the originals in the file, and stamped that copy:

### COPY OF PAPERS ORIGINALLY FILED

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If applicant wants to review the accuracy of the Office's copy of such papers, applicant may either inspect the application (37 CFR 1.14(d)) or may request a copy of the Office's records of such papers (*i.e.*, a copy of the copy made by the Office) from the Office of Public Records for the fee specified in 37 CFR 1.19(b)(4). Please do **not** call the Technology Center's Customer Service Center to inquiry about the completeness or accuracy of Office's copy of the above-identified papers, as the Technology Center's Customer Service Center will **not** be able to provide this service.

If applicant does not consider the Office's copy of such papers to be accurate, applicant must provide a copy of the above-identified papers (except for any U.S. or foreign patent documents submitted with the above-identified papers) with a statement that such copy is a complete and accurate copy of the originally submitted documents. If applicant provides such a copy of the above-identified papers and statement within **THREE MONTHS** of the mail date of this Office action, the Office will add the original mailroom date and use the copy provided by applicant as the permanent Office record of the above-identified papers in place of the copy made by the Office. Otherwise, the Office's copy will be used as the permanent Office record of the above-identified papers (*i.e.*, the Office will use the copy of the above-identified papers made by the Office for examination and all other purposes). This three-month period is not extendable.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-7 and 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Re-claim 1, in line 8 the damping valve is recited as being arranged in the piston, in lines 9-10 the damping valve is recited as being arranged in one of the piston and the piston rod. It is unclear as to the intended location of the damping valve. Does the applicant intend to claim the damping valve in the piston, in the piston rod, or one of the piston and piston rod. For examination purposes the claims will be examined with the damping valve arranged in the piston, this is supported by the arguments.

Claims 2-7 and 9-10 are rejected due to their dependence upon claim 1.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-6, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi et al.

Re-claim 1, Kobayashi et al. discloses a vibration damper with a variable damping force, comprising: a working cylinder 12; a piston, defined as the combination of pistons 14 and 92, fastened to a piston rod, the piston structure divides the working cylinder into two working chambers 28 and 30; first 36 and second 42 non-return valves are arranged in the piston portion 14, the non-return valves provide a damping force for the rebound and compression directions; a

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damping valve 90 is arranged in the piston portion 92, the damping valve comprises a valve body 94 and a valve seat that define a flow path therebetween, the damping valve has a variable damping action and is arranged in series with each of the first and second non-return valves, thereby acting in both the rebound and compression directions, the damping valve arranged in series with the non-return valve will define a sole passage for the damping medium as it passes through the piston when exchanged between the two working spaces. The first piston 14 and the second piston 92 are considered as a single entity since they are fixedly attached to one another. The phrase "comprising" does not preclude the existence of other elements in the prior art.

Re-claim 2, the damping valve of Kobayashi et al. comprises an externally activated actuator for adjusting the variable damping action, see column 5 lines 45-49 and column 6 lines 14-19.

Re-claim 3, the first and second non-return valves are spring loaded valve disks.

Re-claims 4 and 10, the damping valve of Kobayashi et al. has precontrollable settings, such as high damping force and low damping force, see column 5 lines 45-49 and column 6 lines 14-19.

Re-claim 5, Kobayashi et al. discloses an electromagnet, or solenoid, as the actuator for the damping valve.

Re-claim 6, the first and second non-return valves are accommodated together in the piston.

Re-claim 9, the first and second non-return valves communicate with the lower working space 28 and the damping valve actuates via the flow connection to the upper working space 30.

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***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al.

The first and second non-return valves are fixedly connected to the piston by element 44. Kobayashi et al. are silent as to if the non-return valves are preassembled as a modular unit. The examiner takes official notice that the non-return valves and associated seats are illustrated as a modular unit, and that pre-assembling the unit would have been easier prior to inserting the modular unit into the working cylinder. It would have been obvious to one of ordinary skill in the art to have preassembled the non-return valves and associated valve seats prior to their insertion into the working chamber, thus easing the assembly of the vibration damper.

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***Response to Arguments***

11. Applicant's arguments filed January 18, 2002 have been fully considered but they are not persuasive. As mentioned in the above rejection of claim 1, the phrase "comprising" does not preclude the existence of additional elements, such as an inner and outer cylinder. It is noted that the applicant's instant invention is illustrated in figure 1 as having an outer cylinder encasing the inner cylinder as well as a valve system communicating the working chambers with a space formed between the inner and outer cylinders. Pistons 14 and 92 are fixedly attached to one another and move in unison with one another, therefore the individual piston elements can be read as one. Furthermore, there exists only one passage through the piston structure, this sole passage comprises the damping valve in series with the non-return valves.

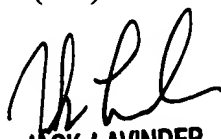
12. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Thomas Williams whose telephone number is (703) 305-1346. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder, can be reached at (703) 308-3421. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

TJW

April 4, 2002

  
JACK LAVINDER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3800

4/5/02